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JAN 26 2005

TECHNOLOGY CENTER 3600

In re Application of:
Michael J. Mitrovich
Serial No. 10/812,666
Filed: March 29, 2004
For: STICK LUBRICANT AND APPLICATOR

DECISION ON PETITION TO MAKE SPECIAL (INFRINGEMENT & ENERGY)

This is a decision on the petition filed November 11, 2004 under 37 CFR 1.102 (c) and 37 C.F.R §1.102(d) to make the above-identified application special under the accelerated examination procedure set forth in MPEP 708.02, Section II: Infringement and VI: Energy.

A grantable petition to make an application special under 37 C.F.R. 1.102 (c), MPEP 708.02, Section VI for an invention which materially contributes to (A) the discovery or development of energy resources, or (B) the more efficient utilization and conservation of energy resources must be accompanied by statements under 37 CFR 1.102 by applicant or his attorney explaining how the invention materially contributes to category (A) or (B) set forth above.

The petition states that the present invention conserves energy in that it reduces rail car friction thereby increasing fuel efficiency of the railroad industry. However, applicant has not provided any facts in support of this statement. The petition should include an explanation describing the features and/or uses of the claimed invention which result in the conservation of energy. Additionally, the petition itself should provide all the facts necessary to render a decision. For example, it is unclear what is meant or encompassed by "reduced rail car friction" or "increasing fuel efficiency". The statement is inadequate to establish for the record the discovery or development of energy resources, or more efficient utilization and conservation of energy resources.

For the above stated reasons, the petition to make special under 37 C.F.R. 1.102 (c), MPEP 708.02, Section VI: Energy is **DISMISSED**.

MPEP 708.02 states that a Petition to Make Special based on Infringement must have the following: (1) the appropriate petition fee under 37 CFR 1.17(h); (2) a statement by the assignee, applicant, or attorney alleging: (A) that there is an infringing device or product actually on the market or method in use; (B) that a rigid comparison of the

alleged infringing device, product or method with the claims of the application has been made, and that, in his or her opinion, some of the claims are unquestionably infringed; and (C) that he or she has made a careful and thorough search of the prior art, or has good knowledge of the prior art, and has sent a copy of the references deemed most closely related to the subject matter encompassed by the claims.

The petition lacks requirement 2(C) above. While applicant states that he has made a thorough search of the prior art and has good knowledge of the pertinent prior art no copies or list of the art has been provided. Applicant should provide a listing of the pertinent prior art or most closely related subject matter. If pertinent prior art or the most closely related subject matter is provided such is a sufficient showing for the petition process. However, for examination purposes applicant should provide the pertinent prior art in an IDS.

In view of these deficiencies, the petition to make under 37 C.F.R §1.102(d), MPEP 708.02, Section II: Infringement is **DISMISSED**.

Any request for reconsideration must be filed within TWO MONTHS of the date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Should petitioner desire reconsideration, he should supplement this petition by a declaration or statement giving the information as outlined above. Applicant should promptly submit a renewed petition to the

Commissioner of Patents and Trademarks, Washington, D.C. 20231. The envelope should indicate that the correspondence be brought to the attention of Technology Center 3600.

Until the renewed petition is submitted, the application will be returned to the examiner's docket to await treatment on the merits in the normal order of examination.

Randolph A. Reese

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RAR/jwk 1/24/05